

In response to that Office Action, please consider the following remarks.

REMARKS

I. Status of the Claims.

This application has been reviewed in light of the Office Action dated November 8, 2002. Claims 53 and 55-58 are presented for examination. Claim 53 is in independent form. Favorable reconsideration is requested.

II. Rejection for Obviousness-type Double Patenting.

Claims 53 and 55-58 stand rejected under the doctrine of obviousness-type double patenting over Claims 1-46 of U.S. Patent 6,015,200 (the '200 patent).

A. The Claims of the '200 Patent Do Not Teach or Suggest All the Limitations of Claims 53 and 55-58.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Moreover, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

Claim 53

Independent Claim 53 is directed to an image reading apparatus including an illuminating device adapted to illuminate an original and a photoelectric converting

device adapted to effect photoelectric conversion on the light from the original. The illuminating device includes a light conductive member for receiving light.

Claim 53 recites that the light conductive member includes a light entrance face provided in at least a part of a first side that forms a longitudinal lateral face of a rod-shaped translucent member. A first light reflecting and/or diffusing area is provided on a second side opposed to the light entrance face and is inclined relative to a light axis of the received light. The first light reflecting and/or diffusing area is adapted to reflect and/or diffuse the entering light within the translucent member. A light exit area is adapted to emit at least a part of the light to the outside of the translucent member. A second light reflecting and/or diffusing area is provided on the first side. The second light reflecting and/or diffusing area is adapted to reflect and/or diffuse the light to the light exit area and is inclined with respect to a longitudinal axis of the translucent member.

These features may be understood by referring, for example, to Figure 5A, which shows light being reflected by a first inclined area (e.g., 6) and a second inclined area (e.g., the surface from which the light is reflected after being reflected by the first inclined area). Of course, this is but one embodiment and in no way limits the scope of the claims.

As the Examiner acknowledges, the claims of the '200 patent do not disclose a second light reflecting and/or diffusing area that is inclined with respect to a longitudinal axis of the translucent member, as recited in Claim 53. The Examiner asserts that such a feature would have been an "obvious engineering design choice," but provides

no factual basis for this conclusion. Applicants respectfully traverse the Examiner's assertion and request that the Examiner cite a reference in support of this position, in accordance with M.P.E.P. § 2144.03.

Because the cited art has not been shown to teach or suggest all of the claimed limitations, Applicants respectfully submit that *prima facie* obviousness has not been established and the rejections based on the claims of the '200 patent should therefore be withdrawn.

Claims 55-58

Claims 55-58 are each dependent from independent Claim 53, discussed above, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

B. There Would Have Been No Motivation For One of Ordinary Skill in the Art to Modify the Claimed Invention of the '200 Patent in the Manner Suggested by the Examiner.

It is fundamental that to establish *prima facie* obviousness the Examiner bears the burden of providing factual support for some suggestion or motivation to modify or combine cited references.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or

the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”

M.P.E.P. § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Moreover, the Federal Circuit has recently emphasized that “a showing of a suggestion, teaching, or motivation to combine prior art references is an ‘essential component of an obviousness holding’” *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). This showing must be specific: “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *Id.* (citation omitted).

As an initial matter, nothing in the claims of the ‘200 patent expressly or impliedly suggests a second light reflecting and/or diffusing area that is inclined with respect to a longitudinal axis of the translucent member, as recited in Claim 53. Indeed, the Examiner has not relied on the claims of the ‘200 patent for such a suggestion. Rather, the Examiner puts forth the following explanation of why one of ordinary skill in the art would have been motivated to modify the claimed invention of the ‘200 patent in the manner hypothesized in the Office Action:

It would have been an obvious engineering design choice to modify the second reflector of U.S. Patent No. 6,015,200 so as to be inclined with respect to the translucent member’s longitudinal surface in order to efficiently transmit light to the light exit area.

Office Action at page 3. However, the Examiner provides no factual support for the assertions that such a modification would be an “obvious engineering design choice” or would “efficiently transmit light to the light exit area.” It is therefore respectfully submitted that the Examiner’s rationale for modifying the claims of the ‘200 patent does not rise to the level of a “convincing line of reasoning.” It is further submitted that the Examiner has not met the burden of establishing a factually-supported showing of a suggestion to modify the prior art in the manner proposed.

Finally, Applicants respectfully submit that the mere existence of engineering design choices does not render such choices obvious *per se*, as the Examiner seems to suggest. To the contrary, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990))(emphasis in original). In this case, as discussed above, no such suggestion in the prior art has been identified.

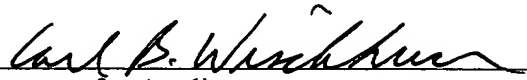
Accordingly, Applicants respectfully submit that *prima facie* obviousness has not been established and the rejections based on the claims of the ‘200 patent should therefore be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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